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Leslie S. Garmaise, Esq.
Dorr, Carson, Sloan & Birney, P.C.
3010 East 6th Avenue
Denver, CO 80206

EXAMINER

JONES, SCOTT E

ART UNIT PAPER NUMBER

3713

DATE MAILED: 12/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/660,291

Applicant(s)

VANCURA, OLAF

Examiner

Scott E. Jones

Art Unit

3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,6-13,15-19 and 30-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,6-13,15-19 and 30-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This office action is in response to the amendment filed on September 13, 2004 in which applicant amends the specification, the abstract, submits a new oath, amends claims 1, 6, 7, 9-13, 15, 17, cancels claims 2, 5, 14, 20-29, adds new claims 30-38, and responds to the claim rejections. Claims 1, 3, 4, 6-13, 15-19, and 30-38 are pending.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 3-4, 6, 7, 9-13, 15-19, 30-31, 34, and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Slomiany et al. (U.S. 6,159,098).

Slomiany et al. discloses an apparatus and method for operating a gaming machine under the control of a processor operable in a basic mode and a bonus mode, selecting a basic game outcome from a plurality of basic game outcomes, the basic game outcomes including a start-bonus outcome, shifting operation of the processor from the basic mode to the bonus mode upon obtaining the start-bonus outcome, starting a bonus game, and selecting, one at a time, one or more of the selection elements in the bonus mode until encountering an end-bonus penalty, and shifting operation of the processor back to the basic game mode from the bonus mode. Slomiany et al. additionally discloses :

Regarding Claim 1:

Art Unit: 3713

- receiving a wager for the casino game in said normal play mode (basic play mode) (Column 3, lines 5-14 and 22-37);
- generating a game outcome in response to receiving the wager in normal play mode (Column 3, lines 22-50);
- initiating the free play mode (bonus play mode) when the game outcome matches a first game outcome (Column 3, lines 34-48, Column 6, lines 1-6, and Claim 12);
- continuing in said free play mode (bonus play mode) to play the casino game until the game outcome matches a second game outcome (end bonus penalty-bomb (30i or 30h)) which stops the free play mode and returns the casino game to the normal play mode (basic play mode) (Claim 12 and Figure 6).

Regarding Claim 3:

- randomly entering the free play mode (bonus play mode) from the normal play mode (Column 3, lines 34-48, Column 6, lines 1-6, and Claim 12);
- randomly entering the normal play mode (basic play mode) from the free play mode (end bonus penalty-bomb (30i or 30h)), such that the frequency of entering the free play mode from the normal play mode is less than the frequency of entering the normal play mode from the free play mode (Claim 12 and Figures 6 and 10). The probability (of obtaining a three-Pig combination (0.007234)) and thus the frequency of entering the bonus game is less than the probability (of obtaining a Bomb symbol in the bonus game 0.1) and the frequency of obtaining a "Bomb" symbol to place a player back in the normal play mode.

Regarding Claim 4:

Art Unit: 3713

- wherein said randomly entering said normal play mode from said free play mode provides a variable number of consecutive plays of said casino game between different instances of said free play mode (Claim 12 and Figures 6 and 10). The probability (of obtaining a three-Pig combination (0.007234)) and thus the frequency of entering the bonus game is less than the probability (of obtaining a Bomb symbol in the bonus game 0.1) and the frequency of obtaining a "Bomb" symbol to place a player back in the normal play mode..

Regarding Claims 6 and 15:

- initiating said normal play mode (basic play mode) of said casino game (Column 3, lines 5-14 and 22-37);
- entering said free play mode (bonus play mode) of said casino game from said initiated normal play mode (Column 3, lines 34-48, Column 6, lines 1-6, and Claim 12);
- enabling play of the casino game to remain in said free play mode for a variable number of plays (trials) of said casino game (Column 9, lines 23-39 and Claim 12); and
- exiting said free play mode of said casino game upon completion of said variable number of plays (Claim 12).

Regarding Claim 7:

- for a given casino game outcome, paying a multiplier award equal to the normal-play-mode award for said given casino game outcome multiplied by a multiplying factor (X1), for at least a portion of said plays of said casino game in said free play mode

(Column 7, lines 12-29). In the bonus game, the first trial is guaranteed to be a successful trial. That is, the normal prize (multiple of one), is awarded for the first pig selected. Afterwards, bonus credits can be obtained by successfully selecting more pigs without selecting an end-bonus-penalty.

Regarding Claim 9:

- paying only said normal-play-mode award level for bonus game awards occurring in said free play mode (Column 7, lines 12-29 and Figure 8). In the bonus game, the first trial is guaranteed to be a successful trial. That is, the normal prize (multiple of one), is awarded for the first pig selected. The normal prize is additionally selected for at least the next two successful trials. Afterwards, bonus credits can be obtained by successfully selecting more pigs without selecting an end-bonus-penalty.

Regarding Claim 10:

- said initiating comprises receiving a wager from said player (Column 3, lines 5-14 and 22-37).

Regarding Claim 11:

- permitting said play of said casino game to remain in said free play mode until a randomly occurring triggering event (end bonus penalty-bomb (30i or 30h)) takes place (Claim 12 and Figure 6).

Regarding Claim 12:

- ending said play in said free play mode upon incurring an appearance of a stop symbol (end bonus penalty-bomb (30i or 30h)) in a game outcome during said free-play-mode play (Claim 12 and Column 7, lines 30-57).

Art Unit: 3713

Regarding Claim 13:

- selecting a free-play-mode value (select one of ten pigs having associated values attached) at random from a plurality of values (Figure 5).

Regarding Claim 16:

- randomly generating said particular game outcome from a plurality of possible game outcomes (Claim 12).

Regarding Claim 17:

- generating a game outcome for each play of the casino game in said free play mode (Claim 12);
- evaluating, after each said play of said casino game in said free play mode, whether said game outcome includes a signal operative to stop said free play mode (Claim 12); and
- ending said free play mode only if said stop signal is provided (Claim 12).

Regarding Claim 18:

- providing an at least substantially equal probability of inclusion of said stop signal in said game outcome for each said play of said casino game in said free play mode (Column 7, lines 1-47).

Regarding Claim 19:

- providing an identical probability of inclusion of said stop signal in said game outcome for each said play of said casino game in said free play mode (Column 7, lines 1-47).

Regarding Claim 30:

Art Unit: 3713

- the message is displayed as a message symbol as one of the plurality of symbols in said game outcome. The examiner asserts obtaining three "Pig" symbols in alignment with payline (22) causes the processor (40) to trigger play of a bonus game shown on display (24) (Column 6, lines 3-6). The three "Pig" symbols equate to a special symbol or message to the player that a bonus game has been triggered and the player is now to select "Pig" symbols in a bonus game.

Regarding Claim 31:

- the casino game is a slot game and wherein the normal play mode are reel spins to a game outcome on wagered pay lines (Column 3, lines 5-14 and 22-50).

Regarding Claim 34:

- a number of hidden values are randomly chosen from a set of hidden values to correspond to the number of symbols in said plurality of symbols, at least one of the hidden symbols in the set being the free play mode symbol. Slomiany discloses selecting a free-play-mode value (select one of ten pigs having associated values attached) at random from a plurality of values (Figure 5). Simply stated, each time a "Pig" symbol, rather than a "Bomb" symbol, is selected in the bonus game equates to another free spin in the bonus game.

Regarding Claim 35:

- at least one of the hidden symbols in the set is an award value symbol (Figures 5 and 6).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 8, 32-33, and 36-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slomiany et al. (U.S. 6,159,098).

Slomiany et al. discloses to one having ordinary skill in the art that as discussed above regarding claims 1, 3-4, 6, 7, 9-13, 15-19, 30-31, 34, and 35. However, Slomiany et al. seems to lack explicitly stating:

Regarding Claim 8:

- the multiplying factor equals three.

Regarding Claim 32:

- the normal play mode and the free play mode use the same reels to spin to game outcomes and wherein the message symbol converts to the stop symbol when the free spin symbol is revealed.

Regarding Claim 33:

- each symbol in the plurality of symbols in the game outcome for normal play has an associated hidden value.

Regarding Claim 36:

- at least one of the hidden symbols in the set is a null symbol.

Regarding Claim 37:

- wherein at least one of the hidden symbols in the set is a multiplier symbol.

Regarding Claim 38:

- wherein the number of hidden symbols randomly chosen is less than the number of hidden symbols in the set so that not every game outcome having the randomly displayed message has the hidden value of a free play symbol.

However, Slomiany et al. does teach that additional bonus credits are provided for a number of successful trials in the bonus game. Game award multipliers are notoriously well known in the gaming arts. It would have been obvious at the time of applicant's invention to utilize game award multipliers, such as 3X, to enhance a player's award rather than providing additional bonus credit values. One would be motivated to do so because for each successful trial in the bonus game the player would obtain an additional game award multiplier making the bonus game much more exciting each time a selection is made.

Regarding Claims 32-33 and 36-38, it would have been obvious at the time of Applicant's invention to incorporate these features in Slomiany because each of these features are notoriously well known in the art. Furthermore, Slomiany specifically teaches the Big Piggy Bankin™ game may include different numbers of selection elements, different graphical symbols identifying the various selection elements, different values of selection-based awards and/or quantity-based awards, different payback percentages, etc.

Response to Arguments

6. Applicant's arguments filed September 13, 2004 have been fully considered but they are not persuasive.

7. Applicant's arguments, see page 11 and the new oath, filed September 13, 2004, with respect to the defective oath have been fully considered and are persuasive. The objection of the oath has been withdrawn.

8. Applicant's arguments, see page 11, filed September 13, 2004, with respect to the objection to the drawings has been fully considered and is persuasive. The objection of the drawings has been withdrawn.

9. Applicant's arguments, see pages 2 and 11, filed September 13, 2004, with respect to the objection to the specification has been fully considered and is persuasive. The objection of the specification has been withdrawn.

10. Applicant's arguments, see page 11 and the replacement abstract, filed September 13, 2004, with respect to the objection to the abstract has been fully considered and is persuasive. The objection of the abstract has been withdrawn.

11. Applicant's arguments, see page 12, filed September 13, 2004, with respect to the objection to claim 5 has been fully considered. The objection of claim 5 is moot in view of the cancellation of the claim.

12. Applicant's arguments, see pages 12 and 13, filed September 13, 2004, with respect to the rejection to claims 3 and 4 under 35 U.S.C. 112, first paragraph have been fully considered and are persuasive. The rejection to claims 3 and 4 under 35 U.S.C. 112, first paragraph has been withdrawn.

13. Applicant's arguments, see page 13, filed September 13, 2004, with respect to the rejection to claims 5 and 25-29 under 35 U.S.C. 112, second paragraph have been fully

considered. The rejection to claims 5 and 25-29 under 35 U.S.C. 112, second paragraph is moot in view of the cancellation of the claims.

14. Applicant's arguments and amendments, see pages 5 and 13, filed September 13, 2004, with respect to the rejection to claims 7-9 under 35 U.S.C. 112, second paragraph have been fully considered and are persuasive. The rejection to claims 7-9 under 35 U.S.C. 112, second paragraph has been withdrawn.

15. Applicant does not agree with the rejection to claims 1, 2, 5, 6, 7, and 9-29 under 35 U.S.C. 102(b) as being anticipated by Slomiany et al. (U.S. 6,159,098). Applicant alleges Slomiany does not disclose or infer, "randomly displaying "a special symbol" in the game outcome to the player to select a symbol in the game outcome." The examiner respectfully disagrees. The examiner asserts obtaining three "Pig" symbols in alignment with payline (22) causes the processor (40) to trigger play of a bonus game shown on display (24) (Column 6, lines 3-6). The three "Pig" symbols equate to a special symbol or message to the player that a bonus game has been triggered and the player is now to select "Pig" symbols in a bonus game. Although the player-selected embodiment is not explicitly disclosed by way of example, Slomiany does disclose, "The bonus game consists of the selection of various elements, one at a time, under player or processor control from a plurality of selection elements having bonus game outcomes assigned thereto (Column 2, lines 2-6)." Therefore, the examiner maintains Slomiany anticipates the claims (*Emphasis Added*).

Regarding the rejection to claims 1, 6, 10-12, and 15-17, Applicant alleges Slomiany does not disclose, "revealing a hidden value behind selected symbol" or "when the selected symbol reveals a free play symbol." The examiner respectfully disagrees. As discussed above,

in the bonus game utilizing player selection, the "Pig" symbols would have to reveal a hidden value behind the "Pig" symbol selected by the player, otherwise the player would continue to select only those "Pig" symbols having winning values; thus running the table each time the bonus game is played. That scenario would not be practical in a casino gaming device. The casino gaming device must return some profit to the casino gaming operator. Furthermore, the examiner asserts obtaining the bonus symbol triggering combination initiates the free play mode (bonus play mode) (Column 3, lines 34-38, Column 6, lines 1-6, and Claim 12). Therefore, the examiner maintains Slomiany anticipates the claims.

Regarding the rejection to claims 7-9, Applicant alleges Slomiany does not disclose multiplying an award by a "Pig" symbol selected in the bonus game. The examiner respectfully disagrees in regards to one scenario in the bonus game. In the bonus game, the first trial is guaranteed to be a successful trial. That is, the normal prize (multiple of one), is awarded for the first pig selected. Afterwards, bonus credits can be obtained by successfully selecting more pigs without selecting an end-bonus-penalty. Applicant alleges Slomiany does not disclose a free spin symbol randomly provided among a plurality of symbols in the game outcome in the free play mode. The examiner respectfully disagrees. Slomiany discloses selecting a free-play-mode value (select one of ten pigs having associated values attached) at random from a plurality of values (Figure 5). Simply stated, each time a "Pig" symbol, rather than a "Bomb" symbol, is selected in the bonus game equates to another free spin in the bonus game. Therefore, the examiner maintains Slomiany anticipates the claims.

Regarding the rejection to claims 18 and 19, Applicant alleges Slomiany does not teach these claims because when each "Pig" symbol is selected, a "Bomb" symbol (stop symbol) is

Art Unit: 3713

added and the probabilities thereafter for selecting a "Bomb" symbol increases. The examiner agrees Slomiany's game proceeds in this manner in the processor controlled embodiment. However, in the player controlled embodiment, the player would not select any of the "Bomb" symbols because that would end the game. Instinctively, the player would select one of the "Pig" symbols whose value/award has not been revealed, therefore, providing an at least substantially equal probability of including said stop symbol (Bomb symbol) for each turn in the casino game. Therefore, the examiner maintains Slomiany anticipates the claims.

16. Applicant does not agree with the rejection to claim 8 under 35 U.S.C. 103(a) as being unpatentable over Slomiany et al. (U.S. 6,159,098) for the same reasons provided above. The examiner respectfully disagrees. Please see Item No. 15:

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott E. Jones whose telephone number is (571) 272-4438. The examiner can normally be reached on Monday - Thursday, 6:30 A.M. - 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on (571) 272-7147. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3713

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Scott E. Jones
Examiner
Art Unit 3713

sej

A handwritten signature in black ink, appearing to read "Scott E. Jones", written in a cursive style.